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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/535,203	04/20/2007	David Gang	10587.0261-00000	1954
22852 7590 07/16/2010 FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413				
EXAMINER ALVAREZ, RAQUEL				
ART UNIT 3688		PAPER NUMBER		
MAIL DATE 07/16/2010		DELIVERY MODE PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/535,203

**Applicant(s)**

GANG ET AL.

**Examiner**

Raquel Alvarez

**Art Unit**

3688

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-48 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-48 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/CD)  
Paper No(s)/Mail Date 6/16/2005
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. This office action is in response to communication filed on 5/17/2005.
2. Claims 1-48 are presented for examination.

**Claim Rejections - 35 USC § 101**

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Based on Supreme Court precedent <sup>1</sup> and recent Federal Circuit decisions, a 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. <sup>2</sup> If either of these requirements is met by the claim, the method is non a patent eligible process under § 101 and should be rejected as being directed to non-statutory subject matter.

**Claim 1** is rejected under 35 U.S.C. 101 as drawn to a non-statutory subject matter. The applicant is reciting only method steps such as "classifying....determining...presenting", the applicant has not recited an apparatus or device to perform these limitations and without apparatus or device these limitations are just mental steps. Mentioning computer in the preamble is not enough, if the body of the claims each of the steps can be performed manually.

In claim 1 the steps are related to a mental process, which is not patentable. Indeed, it is not tied to another statutory class or does not change or switch statutory

class (such as a particular apparatus or physical module or device) or does not transform the underlying subject matter (such as an article or materials) to a different state or thing. See MPEP §2106.IV.B: *Determine Whether the Claimed Invention Falls Within An Enumerated Statutory Category*.

Examiner suggests applicant inserts a device in one or more essential steps of the body of the claims in order to overcome this rejection.

<sup>1</sup> Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972); Cochrane v. Deener, 94 U.S. 780, 787-88 (1876).

<sup>2</sup> The supreme court recognized that this test is not necessary fixed or permanent and may evolve with technological advances. Gottschalk v. Benson, 409 U.S. 63,71 (1972)

**Claim Rejections - 35 USC § 102**

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

5. Claims 1-6, 8-21, 23-29, 31-47 are rejected under 35 U.S.C. 102(a) as being anticipated by Crawford (7,546,537 hereinafter Crawford).

With respect to claims 1, 4, 8-13, 19, 23-27, 31-33, 41, Crawford teaches methods and system for automatically classifying content perceived by a sharing user (i.e. selecting from a list of category)(Figures 8-9); determining a set of recipient candidates likely to be interested in the content based upon classification of the content and prior sharing activity of the recipients to content of the same or similar classification and presenting to the sharing user one or more members of the set of recipient

candidates for sharing the content being perceived by the sharing user based upon passive personalization(i.e. the user is presented with a list of subscribers/buddies with similar interests); updating the sharing list (i.e. family, colleagues and buddy list is updated).

With respect to claims 2-3, Crawford teaches wherein the content comprises Internet online content (see Figures 4-5).

With respect to claims 5, 28 Crawford further teaches determining the set of recipient candidates comprises doing so based upon information made available by a potential recipient (i.e. subscriber can supply and edit their profile)(col. 10, lines 35-42).

With respect to claims 6, 29 Crawford further teaches determining the set of recipient candidates comprises doing so based upon active manipulation by the sharing user (i.e. the user can supply the buddy list of family, friends with similar interests)(Figures 8-9).

With respect to claim 14, Crawford further sharing the content using at least one of an instant message, a chat room and an e-mail message (i.e. Typically, the OSP host complex 380 supports different services, such as email, discussion groups, chat, news services, and Internet access).

With respect to claim 15-17, 34-36, 42-44 Crawford further recites receiving an online presence status for one or more members of the set of recipient candidates and presenting to the sharing user one or more communication options for sharing the content with a recipient candidate based upon the online presence status of the recipient candidate (i.e. determining when other subscribers (buddies) are online in order to present the information)(col. 10, lines 16-34).

Claim 45 is similar in scope as claim 14 rejected above and therefore is rejected under similar rationale.

With respect to claims 18, 37, Crawford further teaches classifying the content comprises identifying a change in the content and determining a set of recipient candidates comprises determining a set of recipient candidates based upon the changed content (i.e. changing the category will lead to a change in the buddy list).

With respect to claims 20-21, 46-47 Crawford teaches determining if the content is shareable and sending an indication such as a visual and audible indication of such (i.e. visual display of the shareable content (Figures 8-9).

With respect to claims 38-40, Crawford further teaches storing the set of recipients as a sharing list and retrieving and updating the sharing list (see adding updating and storing buddy list on Figures 8-9).

**Claim Rejections - 35 USC § 103**

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 7, 22, 30 and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Crawford in view of Official Notice.

Claims 7, 30 further recites the set of recipient candidates being supplied by a third party. Official notice is taken that it is old and well known to delegate responsibilities and duties to a third party. For example, collector's agency for collecting late/unpaid payments. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included the set of recipient candidates being supplied by a third party in order to achieve the above mentioned advantage.

Claims 22, 48 further recite sending an audible indication that the content is shareable. Crawford teaches visual display of the shareable content (Figures 8-9). Crawford doesn't specifically teach the indication being audible. Official Notice is taken that it is old and well known to provide a noise or sound to be heard in order to alert the users. For example, hazard weather alert while watching a TV show. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to

have included the indication being audible in order to achieve the above mentioned advantage.

**Point of contact**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raquel Alvarez whose telephone number is (571)272-6715. The examiner can normally be reached on 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynda Jasmin can be reached on (571)272-6782. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Primary Examiner, Art Unit 3688

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R.A.



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7/15/2010